AMENDMENT, RESPONSE AND REQUEST FOR CONTINUED EXAMINATION UNDER 37 CFR § 1.114   Page 12
Serial Number: 09/976,301   Dkt: 2043.053US1
Filing Date: October 11, 2001
Title: SYSTEM AND METHOD TO FACILITATE TRANSLATION OF COMMUNICATIONS BETWEEN ENTITIES OVER A NETWORK

REMARKS

This responds to the Final Office Action mailed on <u>March 17, 2008</u>. This response includes a Request for Continued Examination under 37 C.F.R. 1.114 to reopen prosecution from an Appeal that was initiated with a notice of Appeal mailed on June 16, 2008.

Claims 1, 5, 12, 16, 23, 27, 34, 38 and 45 are amended, claims 3, 9, 14, 20, 25, 31, 36 and 42 are canceled, and no claims are added; as a result, claims 1, 2, 4–8, 10-13, 15-19, 21–24, 26-30, 32–35, 37–41, and 43-48 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 4-5, 9-12, 15-16, 20-23, 26-27, 31-34, 37-38 and 42-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan et al. (U.S. Patent No. 5,966,685; hereinafter "Flanagan") in view of Gastaldo et al. (U.S. Patent No. 6,473,729; hereinafter "Gastaldo").

Applicable Law

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. §2142. Further, "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"[1]

Applicant respectfully submits that the rejection of claims 1, 4-5, 9-12, 15-16, 20-23, 26-27, 31-34, 37-38 and 42-45 under 35 U.S.C. § 103 is defective for failing to make a prima facie showing of obviousness.

Argument

Applicant believes that the issue of patentablity over Flanagan in combination with Gastaldo is best understood with regard to the limitations of claim 1.

---

[1] *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) cited with approval in *KSR v Teleflex*, 550 U.S. at ___ , 82 USPQ2d at 1396 .

Claim 1 includes the following limitations:

> *...responsive to receipt of a selection by said first entity of a language construct of said plurality of predetermined language constructs, identifying a translated language construct corresponding to said first language construct...*

> *...said identifying further comprises:*

>> *retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity; and*

>> *retrieving said translated language construct from a table based on said entity information and said first language construct.*

Applicant notes that Flanagan relates the following first and second quotes:

The present invention is a system of parallel discussion groups operated in conjunction with a message collection/posting software program, data filter software program, and a machine translation software program. The present invention comprises a number of discussion groups running in "parallel"; one group for each language being used in the discussion groups. The individual discussion groups all contain the same information, in the same order; the only difference being that each parallel discussion group is written in a different language.[2]

....No human intervention is required for the pre-processing, translation, or post-processing functions. Additionally, users simply specify a language preference to realize the benefits and advantages of the present invention.[3]

The above quotes from Flanagan relate to a system of parallel discussion groups, one group for each language being used in the discussion groups. The parallel discussion groups operate in conjunction with software programs[4]. The software programs perform message collection, message posting, filtering, and translation[5]. The software programs include a machine

---

[2] Flanagan, column.2, lines 21-30 (first quote)
[3] Id., column. 3, lines 19-25 (second quote)
[4] Flanagan, column.2, lines 21-30 (first quote)
[5] Id.

translation software program to perform message translation[6]. The first quote further relates the discussion groups as running in parallel and containing the same information though written in different languages.[7]

The second quote relates that no human intervention is required for pre-processing, translation or post processing. Indeed, users who desire to view messages are merely required to login to a particular discussion group and specify a language preference.[8] Flanagan emphasizes the desirability of such an approach by stating, "Users simply specify a language preference that is communicated to the network in order to take advantage of the present invention." [9]

Applicant further notes that with respect to Flanagan the Final Office Action concedes: "Flanagan does not specifically teach communicating a plurality of predetermined language constructs" [10] or "receipt of a selection by said first entity of a language construct of said plurality of predetermined language constructs." [11] Instead, the Final Office Action relies on Figures 5-7 and supporting text from Gastaldo.

Gastaldo relates to a system for "assisting a translator to get the right translation for any phrase."[12] To assist the translator, Gastaldo, refers to a window 51, shown in Fig. 5 of that patent:

---

[6] Id.
[7] Id.
[8] Id., column. 2, lines 31-39
[9] Id., column. 2, lines 47-49
[10] Final Office Action, page 3, #9
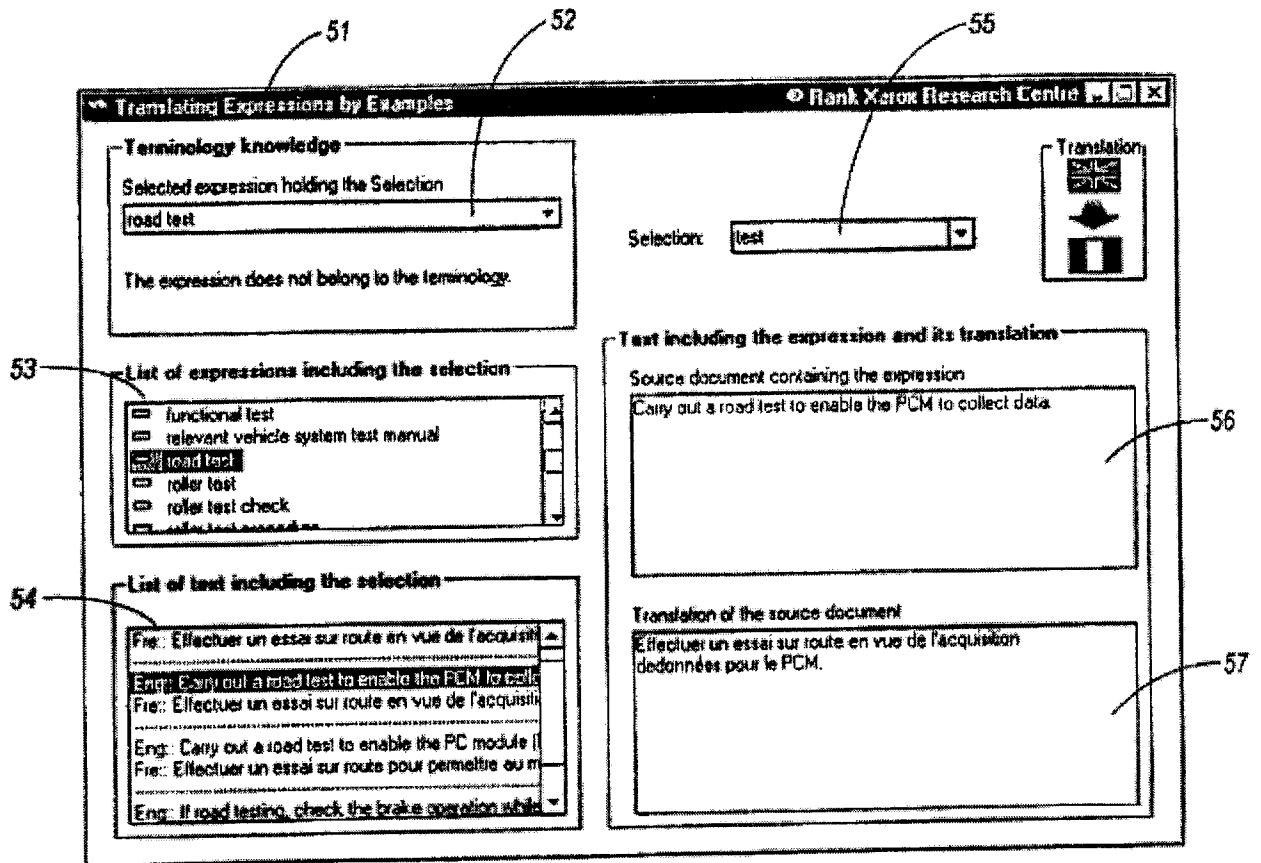[11] Id., page 3, #10.
[12] Gastaldo, column 1, line 7

FIG. 5

In Gastaldo, first, the translator inputs a word (e.g., "test") for translation (callout 55).[13] Responsive to the input, the window 51 displays "noun phrases" containing the word "test" (callout 53).[14] A "noun phrase" "is a "group of two or more associated words, not containing a subject and predicate" further "involving either pronouns or nouns."[15] Second, the translator further selects a particular noun phrase (e.g., "road test") (callout 53).[16] Responsive to the selection, the window 51 displays pairs of sentences (callout 54) previously indexed according to the noun phrase "road test" from a sentence database.[17] The sentence database stores "a plurality of sentences in English as the source language, and also stores to each English sentence the

---

[13] Id., column 5, line 50 – column 6, line 17
[14] Id.
[15] Id., column 4, lines 3 – 11.
[16] Id., column 5, line 50 – column 6, line 17
[17] Id.

AMENDMENT, RESPONSE AND REQUEST FOR CONTINUED EXAMINATION UNDER 37 CFR § 1.114   Page 16
Serial Number: 09/976,301   Dkt: 2043.053US1
Filing Date: October 11, 2001
Title: SYSTEM AND METHOD TO FACILITATE TRANSLATION OF COMMUNICATIONS BETWEEN ENTITIES OVER A NETWORK

corresponding sentence in French as the target language."[18] Each pair of sentences, as displayed in window 51 (callout 54), includes an English sentence and a French sentence that contain the noun phrase "road test." Third, the translator selects one of the displayed sentences. Responsive to the selection, the selected pair of sentences is displayed in the window 51 (callouts 56, 57)[19] to facilitate a study of the selected sentences. Finally, the translator selects a pair of sentences to be used for translation.[20] Responsive to the selection, a phrase extractor extracts the noun phrase translation and inserts the translated noun phrase automatically into a translation of the input text.[21]

Claim 1, as amended, requires *"retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity and retrieving said translated language construct from a table based on said entity information and said first language construct."* Accordingly, claim 1 requires a first entity to select a language construct and an identifier of a second entity. Flanagan fails to disclose any such double selection by a first entity. Indeed, Flanagan relates parallel discussion groups where a user logs in and specifies a language preference to view messages. Nowhere does Flanagan describe the limitations of claim 1 which require *"retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity"* much less does Flanagan describe *"retrieving said translated language construct from a table based on said entity information and a language construct selected by the first entity."* Indeed, Flanagan simply relates a machine translation software program to perform message translation and emphasizes that no human intervention is required for pre-processing, translation or post processing.

Gastaldo further fails to disclose any such double selection by a first entity. Indeed, Gastaldo relates a system for "assisting a translator to get the right translation for any phrase" without regard to any "second entity." Accordingly, Gastaldo also fails to relate *"retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity"* much less *"retrieving said translated language construct from a table based on said entity information and said first language construct.* Flanagan and Gastaldo

---

[18] Id., column 4, lines 47 – 53.
[19] Id., column 5, line 50 – column 6, line 17
[20] Id.
[21] Id.

therefore cannot be said to teach or suggest the above quoted limitation, whether considered singly or in the combination proposed in the Final Office Action . Specifically, Flanagan relates parallel discussion groups where a user logs in and specifies a language preference to view messages that are translated without human intervention by a machine translation software program, Gastaldo relates a system for "assisting a translator to get the right translation for any phrase" without regard to any "second entity." In contrast, claim 1 requires *retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity and retrieving said translated language construct from a table based on said entity information and a language construct selected by the first entity*. These are distinguishable actions.

With regard to the combination of Flanagan and Gastaldo, the Advisory Action states:

Gastaldo would enhance the speed of translating sentences that are common while also translating sentences that would be more complex and need an algorithm to decipher.

Applicant respectfully disagrees. Specifically, Applicant disagrees for the reason that Flanagan emphasizes the benefits of translating without "human intervention" and Gastaldo requires a "translator." Flanagan states:

"No human intervention is required for the pre-processing, translation, or post-processing functions. Additionally, users simply specify a language preference to realize the benefits and advantages of the present invention.[22]

In contrast, Gastaldo relates a system for "assisting a **translator** to get the right translation for any phrase." [23] Because of these fundamental differences, Applicant submits that one having ordinary skill in the art who begins with Flanagan would not be motivated to look to Gastaldo to reach the limitations of claim 1. Specifically, Gastaldo teaches a system for "assisting a translator" while Flanagan teaches an automatic system that translates without either a translator or "human intervention."

---

[22] Id., column. 3, lines 19-25
[23] Gastaldo, column 1, line 7

Independent claims 12, 23 and 34 are of scope similar to the scope of claim 1. In view of the arguments presented above with respect to claim 18, Applicant respectfully requests the obviousness rejection of claims 12, 23 and 34 also be withdrawn as failing to make a prima facie showing of obviousness. .

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 4-5, 9-11, 15-16, 20-22, 26-27, 31-33, 37-38 and 42-45 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Gastaldo, and further in view of Scanlan (U.S. Patent No. 6,857,022).

Scanlan relates "a method of ordering a translation of an electronic communication, such as a web page or an email, using a one-click translation component displayed on the web page or in the email. Clicking the one-click translation component automatically requests a translation of the selected communication and returns the communication to the user. The method is controlled by a translation manager that obtains the translation and directs transmission of the translation to the user."[24] Accordingly, Scanlan also fails to disclose the limitations of the independent claims of the present application which require *"retrieving entity information relating to said second entity based on an identifier of said second entity selected by said first entity and retrieving said translated language construct from a table based on said entity information and a language construct selected by the first entity."*

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2, 6-7, 13, 17-18, 24, 28-29, 35, 39-40 and 46-48 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Flanagan, Gastaldo and Scanlan, whether alone or in combination, cannot be said to support a rejection the independent claims as obvious under 35 U.S.C.§ 103 because the rejection is defective for failing to make a prima facie showing of obviousness.

.

---

[24] Scanlan, Abstract.

AMENDMENT, RESPONSE AND REQUEST FOR CONTINUED EXAMINATION UNDER 37 CFR § 1.114   **Page 19**
Dkt: 2043.053US1
Serial Number: 09/976,301
Filing Date: October 11, 2001
Title: SYSTEM AND METHOD TO FACILITATE TRANSLATION OF COMMUNICATIONS BETWEEN ENTITIES OVER A NETWORK

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-278-4051 to facilitate prosecution of this application.
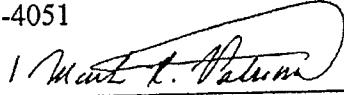
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
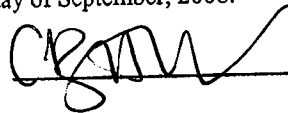408-278-4051

Date   September 29, 2008   By _____

Mark R. Vatuone
Reg. No. 53,719

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this _____ day of September, 2008.

_____

Name

_____

Signature